

Claims 45-46 were rejected pursuant to 35 U.S.C. § 102(e) as anticipated by Higham '456.

Claim 45 was rejected pursuant to 35 U.S.C. § 102(b) as anticipated by Colson '297.

Claims 1-3 and 24-26 were rejected pursuant to 35 U.S.C. § 103(a) over Lavigne.

Claims 45-47 were rejected pursuant to 35 U.S.C. § 103(a) as unpatentable over Higham '456.

Claim 45-46 were rejected pursuant to 35 U.S.C. § 103(a) as unpatentable over Colson '297.

Claims 1, 3, 24-26, 45 and 47 were rejected pursuant to 35 U.S.C. § 103(a) as unpatentable over Lavigne in view of Aten.

Claims 1-3 and 24-25 were rejected pursuant to 35 U.S.C. § 103(a) over Colson '450.

Claims 45-47 were rejected pursuant to 35 U.S.C. § 103(a) over Blechl in view of Weinberger.

Claim 45-47 were rejected pursuant to 35 U.S.C. § 103(a) over Colson '297 in view of Lavigne.

All of these rejections are respectfully traversed.

**The Cited References Do Not Constitute Prior Art  
Against Applicants' Invention**

The present Application is entitled to a priority date pursuant to 35 U.S.C. § 120 of U.S. Patent Application Serial No. 08/361,783 filed December 16, 1994 which is now U.S. Patent No. 5,790,409. A claim in a continuation-in-part application which is directed to subject matter

adequately disclosed under 35 U.S.C. § 112 in the parent application is entitled to the filing date of the parent application. (MPEP § 201.11)

Whenever the requirements of 35 U.S.C. § 120 are met, the Applicants' claim for benefit of the filing date of the prior application is to be allowed without any examination. However, in the case where an intervening reference is cited against the claims of the continuation-in-part application, the issue of whether there is support for the claimed invention in the prior application is a matter to be examined by the Patent Examiner. (MPEP § 706.02 and particularly § 706.02(k))

In response to the prior Action, Applicants pointed out that the Lavigne reference had a filing date after Applicants' effective filing date for the subject matter of the broadest pending claims.

Applicants also submitted a Declaration pursuant to 37 C.F.R. § 131 with the prior response establishing that Applicants reduced to practice the invention claimed in at least claims 24 and 45 prior to the filing date of the Colson '450 reference.

In response to Applicants pointing out that the primary references cited in the prior Action do not constitute prior art, the Patent Office has now cited in the recent Action additional references which are not prior art against Applicants, namely Pearson '232 and Higham '456.

Pearson '232 has a filing date of February 12, 1996. This is subsequent to Applicants' effective filing date of December 16, 1994. There has been no showing by the Patent Office that Pearson '232 is entitled to any earlier filing date. The Patent Office bears the burden of showing "prior art" against the claimed invention. Although Pearson '232 claims the benefit of prior

applications, the Patent Office has not shown that any of those prior applications contain the same disclosure as Pearson '232. As a result Pearson is not prior art.

Even assuming that the Patent Office could establish that Pearson '232 was entitled to an earlier filing date, the earliest date which can be claimed for Pearson is March 7, 1994. The earlier applications of which Pearson '232 claims priority do not include features pertinent to the claimed invention.

Applicants are submitting herewith a Declaration and documentation which establishes that the invention claimed in at least claims 24 and 45 (Pearson '232 being cited only against claim 45) was reduced to practice in this country prior to March 7, 1994, the earliest possible filing date of Pearson. As a result, Pearson '232 cannot constitute prior art against Applicants.

Higham '456 has a filing date of July 14, 1994. The Declaration being submitted herewith establishes that the present invention was reduced to practice in this country prior to March 7, 1994. As a result, Higham '456 also does not constitute prior art against Applicants. Higham is cited only against claims 45-47. The attached Declaration shows that the subject matter of claim 45 was reduced to practice prior to the filing date of Higham.

The Manual of Patent Examining Procedure authorizes Applicants to submit a further Declaration after final action in these circumstances. (MPEP § 715.09) As the Manual of Patent Examining Procedure acknowledges, a Declaration is appropriately received by the Patent Office when a ground for rejection is presented for the first time in a final rejection. In addition or in the alternative, 37 C.F.R. § 1.116(b) specifies that evidence should be received after final action when there are good and sufficient reasons that the evidence was not earlier presented. The fact

that Pearson '232 and Higham '456 were not cited against any of Applicants' claims until the final action constitutes good and sufficient reasons for the presentation of this Declaration.

**The Patent Office Has Not Shown That Applicants  
Are Not Entitled to the Filing Date of the Parent Application**

In commenting on the Declaration submitted with the Response to the prior Action, a comment is made at Paragraph 18 of the Action that:

"There is a rebuttable presumption that the claims rely upon at least one element of new matter (i.e., a lock module mounted to the exterior surface of the housing structure or the refrigeration unit) of Applicant would not have the need to add new matter and would file a continuation application rather than a continuation-in-part application."

What is the legal basis for the "rebuttable presumption"? Applicants demand citation of legal support for this contention in the Action.

Contrary to the assertion in the Action the patent laws state that claims in a continuation-in-part application when supported by a parent application, are entitled to the filing date of that parent application. (MPEP § 201.11) There is no presumption that claims are not supported by a parent application merely because such claims are included in a continuation-in-part application.

The Action also purports to impose a duty on the Applicants to establish that the subject matter claimed is supported by the parent application. The Action states:

"The applicant, in spite of his superior familiarity with the patent application, has not shown where the elements are located in the

parent application nor has the applicant even asserted the parent application contained each element of the claims covered by the '131 affidavit. As such the 102(b) reference date status of the cited art has not been overcome".

Where is there a legal requirement that an applicant must separately show that a claim is supported by a parent application? Applicants demand a citation to legal authority for this proposition.

On the contrary, the Manual of Patent Examining Procedure directs the Patent Office in cases where there is an intervening reference, to examine the parent application from which priority is claimed to determine if the claim is supported by the parent application. (MPEP § 706.02). Because the Patent Office has failed to show any basis or reason that the main claims in the pending application are not supported by the parent application, and because Applicants are entitled to the filing date of the parent application through their compliance with 35 U.S.C. § 120 and MPEP 706.02(k), it follows that Applicants are entitled to the December 16, 1994 filing date of the parent application for the broadest pending claims.

Applicants also wish to respectfully point out that the disclosure in the parent application is fully duplicated in the pending continuation-in-part application along with additional disclosure. The main claims including claims 24 and 45, the subject matter of which was reduced to practice prior to the filing date of the parent application, are fully supported in both the pending application and the parent application. For convenience and for purposes of illustration only, Applicants wish to point out with regard to pending claim 45 as an example, the system shown in Figure 13 of U.S. Patent 5,790,409 which issued on the parent application.

With regard to claim 45 Applicants also point out the discussion at Column 3, lines 12-61 as well as the detailed discussion of the elements and method steps at Column 8, lines 45-50; Column 16, lines 34-37; Column 14, line 65-Column 15, line 3; Column 9, lines 15-37; Column 8, lines 9-24; Column 16, lines 11-33; Column 18, lines 5-29; Column 11, lines 55-61; Column 16, lines 11-23; Column 18, lines 12-29; Column 8, lines 25-54; Column 16, lines 36-39; and Column 16, line 64-Column 17, line 14. It is respectfully submitted that the parent application is rich in disclosing all the elements and method steps claimed in at least claim 45 and claim 24. As the Patent Office has not shown any basis for a contrary position, Applicants' entitlement to the filing date of the parent application is established.

**The Colson '297 Patent Is Not Pertinent**

In the Action it is asserted that the Declaration previously submitted is deficient because it swears behind the filing date of the Colson '450 Patent but does not swear behind the filing date of the Colson '297 Patent. This argument by the Patent Office is without merit.

The Colson '297 Patent was not cited as a reference against the pending claims in the prior Action. The prior response overcame the rejection which was based on Colson '450. It is legally improper for the Patent Office to assert that the prior response does not overcome the rejection because the evidence presented did not "swear behind" a reference that was not the basis for the rejection.

The Colson '450 Patent was granted on a continuation-in-part application of the Colson '297 Patent. The Colson '297 Patent does not include the pertinent features for which the Colson '450 Patent was cited in the prior Action. Specifically and by way of example and without limitation, the Colson '297 Patent does not disclose or suggest a data store including data

representative of a plurality of authorized users, or data representative of a plurality of medical items, or location data corresponding to locations where medical items are stored, or the input of identification data corresponding to data for an authorized user, or enabling a user to input item indicia in response thereto. It is respectfully submitted that even the most cursory evaluation of the Colson '297 Patent establishes that it does not disclose the features for which the later Colson '450 Patent was cited in the prior Action. Further, the recent Action admits that Colson '297 does not disclose these features. Because the rejections from the prior Action based on Colson '450 are restated, this is taken as an admission by the Patent Office that Colson '297 cannot be used in place of Colson '450 in making these rejections.

For these reasons it is respectfully submitted that Applicants do not need to swear behind the Colson '297 reference in order to establish patentability of the present invention.

**Numerous Rejections Are Overcome By Applicants' Prior Invention**

Applicants have established through the prior Declaration and the Declaration enclosed herewith that the subject matter of at least claims 24 and 45 was reduced to practice in this country prior to at least March 7, 1994. As a result the rejections presented in the Action which are based on 35 U.S.C. § 102 are obviated. The paragraphs referenced below correspond to those presented in the Action. These rejections include:

Rejections based on Lavigne (Paragraph 5)

Rejections based on Colson '450 (Paragraph 6)

Rejections based on Pearson '232 (Paragraph 7)

Rejections based on Higham '456 (Paragraph 8)

The Patent Office Rules also provide that when an obviousness rejection is based on one or more references and the applicant swears behind one reference, the obviousness rejection is overcome. (MPEP § 715.03) As a result the following rejections in the Action pursuant to 35 U.S.C. § 103 are obviated because Applicants have sworn behind at least one of the references. These rejections are as follows:

Lavigne alone (Paragraph 11)

Higham '456 alone (Paragraph 12)

Lavigne and Aten (Paragraph 14)

Colson '450 in view of Lavigne (Paragraph 15)

Colson '297 and Lavigne (Paragraph 17)

Applicants also restate as if fully rewritten herein the Response to the prior Action explaining why the pending claims are not anticipated or obvious in view of features in Lavigne, Colson '450 or Aten or any combination of features therein regardless of prior art status. Applicants respectfully disagree with the comment in the Action as inaccurate and not supported, and Applicants intend to continue to argue the issues on appeal.

**Traverse of Withdrawal of Claims From Consideration**

Applicants continue to traverse the withdrawal from consideration of claims 4-23 and 27-44. Applicants incorporate by reference the arguments stated in the Response dated December 30, 1999 as if fully restated herein. Applicants will petition to have the restriction requirement withdrawn prior to the filing of a notice of appeal.

**Applicants' Claims Are Not Anticipated by Colson '297**

In the Action (Paragraph 9) claim 45 was rejected pursuant to 35 U.S.C. § 102(b) as anticipated by Colson '297. This rejection is respectfully traversed.

Colson '297 discloses a dispensing cabinet. The pertinent disclosure of Colson is found in Column 4, lines 39-53. It specifically states that there is a keyboard (65) near the top surface of a supply dispenser station (67). Information is input through the keyboard concerning the particular item needed for a patient and information as to the party entering the information. The input of this information causes electrical impulses to be issued from the dispenser station (67) through a cable (69) to actuate a particular electrical solenoid. This causes a particular door (19) to unlock which permits access to the interior of the cabinet (3). It is respectfully submitted that this disclosure does not anticipate claim 45.

Before a claim may be rejected on the basis of anticipation pursuant to 35 U.S.C. § 102(b) it must be shown that the prior art reference cited contains all the elements of the claimed invention arranged in the manner recited in the claim. Connell v. Sears, Roebuck & Co., 722 F.2d 1042, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983). To make a valid rejection under 35 U.S.C. § 102 requires that the prior art disclosure contain each and every element of the claimed invention arranged and operated such that the prior art reference would literally infringe the claim at issue. Lewmar Marine, Inc. v. Barent, Inc., 822, F.2d 744, 747, 3 U.S.P.Q. 2d 744, 747, 3 U.S.P.Q. 2d 1766, 1768 (Fed. Cir. 1987)

It is respectfully submitted that claim 45 recites features and relationships that are plainly not found in Colson '297. For example claim 45 recites a computer in operative connection with a data store. The data store includes user data representative of a plurality of authorized users.

Claim 45 further recites that responsive to a user inputting identification data corresponding to data for an authorized user that is stored in the data store, the computer operates to enable the user to input item indicia corresponding to a medical item through an input device. Claim 45 further recites that the computer is operative responsive to the input of the item indicia to output at least one signal which changes a lock to an unlocked condition.

In contrast to the elements recited in claim 45, the system in Colson '297 does not disclose a computer with a data store having stored user information corresponding to authorized users. Further, Colson does not have a computer that operates responsive to the input of data that corresponds to one of the authorized users, to enable input of indica which identifies a medical item. Colson '297 operates in the manner expressly stated therein. Inputs through a keyboard identifying a medical item and identifying a person causes a door to open. There is no disclosure or suggestion of comparing the input concerning the person taking the item, to data in a data store containing data for a plurality of authorized users. Colson '297 simply receives the data and apparently stores the data for later recovery. There is no comparison of input data to previously stored data as expressly recited in the claim.

Further there is no disclosure in Colson '297 of a computer that operates in response to determining that the input user data corresponds to one of the authorized users, to then enable input of indicia identifying a medical item. According to Colson '297 identifying information concerning a medical item can be input at any time and is apparently input before information that identifies a user. Colson '297 further fails to disclose or suggest this feature which is expressly recited in claim 45.

Claim 45 also recites that the data store in operative connection with the computer includes location data representative of storage locations in which medical items are stored. The cited portions of Colson '297 do not disclose a data store, nor a data store including location data representative of storage locations in which particular medical items are stored. Further Colson '297 does not disclose the relationship as specifically recited in claim 45, that the computer operates to enable the input of item indicia corresponding to a medical item responsive to receipt of identifying data corresponding to data for an authorized user among a plurality of authorized users for whom data is stored, and the computer then operating responsive to the item indicia to generate a signal changing the condition of the lock to an open condition.

As claim 45 recites these numerous features and relationships that are neither disclosed nor suggested in Colson '297, it is respectfully submitted that claim 45 is allowable.

**The Claims Are Not Obvious In View of the Combination of Blechl and Weinberger**

In the Action claims 45-47 were rejected pursuant to 35 U.S.C. § 103(a) as obvious over the combination of Blechl in view of Weinberger (Paragraph 16). This rejection is respectfully traversed.

Before a claim may be rejected on the basis of obviousness the Patent Office must show that all the recited features of the claim are known in the prior art. (MPEP § 2142) In addition to showing that all the features and relationships are known in prior art references, the Patent Office further bears the burden of showing in the cited art a specific teaching, suggestion or motivation to produce the claimed combination. Panduit Corp. v. Denison Mfg. Co., 810 F.2d 1561, 1568, 1 U.S.P.Q. 2d 1593 (Fed. Cir. 1987). The teaching, suggestion or motivation to combine features in prior art references must be *clearly* and *particularly* identified in such prior art to support a

rejection on the basis of obviousness. In re Dembiczak, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999)

The rejection based on the alleged combination of Blechl and Weinberger is legally improper under this standard for several reasons. First, no specific feature of Weinberger is identified as contributing to the features asserted to be present in Blechl. The discussion of Weinberger in the Action does not point to any feature or any specific area of that disclosure which is asserted to be pertinent to the claims at issue. In addition there is no specific or particular teaching cited in either prior art reference that would cause one skilled in the art to produce a claimed combination. The only comments concerning Weinberger in the Action are as follows:

"It would have been obvious for Blechl to include a visual indicator because a visual signal can direct a user to the correct door/drawer as taught by Weinberger. It would have been obvious for Blechl to have the computer lock the door responsive to a sensor indicating door closure because locking the door can reduce unauthorized access as taught by Weinberger."

Where does Weinberger teach a lock module with a visual signal that directs a user to a correct door/drawer? Where does Weinberger have a computer lock a door responsive to a sensor indicating door closure? Where is there any specific teaching in Weinberger or Blechl to make the asserted combination?

The Manual of Patent Examining Procedure specifically requires that the Patent Office clearly and fully state any grounds for any rejection. (MPEP § 707.07(d)) It is respectfully

submitted that this rejection fails to satisfy those requirements and should be withdrawn as legally improper.

Applicants further wish to point out that claims 45-47 recite numerous features and relationships that are not disclosed in Blechl or Weinberger. For example, claim 45 specifically recites a computer in operative connection with a data store. The data store includes user data representative of a plurality of authorized users. Claim 45 further recites that responsive to a user inputting through at least one input device, identification data that corresponds to one of the authorized users in the data store, the computer enables that user to input item indicia corresponding to a medical item through at least one input device.

Blechl does not disclose a computer in operative connection with a data store, which data store includes data for a plurality of authorized users. Indeed the express description of Blechl's operation makes clear that Blechl does not include a data store which holds information for a plurality of authorized users. Instead Blechl has each user insert a magnetic card which is read by a card reader. Blechl's device then requires the user to input a personal identification number (PIN). The input PIN is then compared to the card which is read and if there is a match, access is allowed (Column 9, lines 13-19; Column 4, lines 23-33). As a result Blechl makes it very clear that it has no computer connected to a data store holding data for a plurality of authorized users. Rather Blechl simply compares the card and PIN input by a single user to determine if the system should be operated.

Claim 45 further recites that responsive to input of data corresponding to one of the plurality of authorized users stored in the data store, the computer of the recited invention enables a user to input item indicia corresponding to a medical item through at least one input

device. The Action asserts that this feature is found in Blechl at Column 4, lines 39-50. This portion of Blechl does not stand for the proposition asserted in the Action. Instead it talks about a mechanic or pharmacist accessing the interior of Blechl's device. It is discussed that such a mechanic or pharmacist can gain access by inputting a matching card and PIN and allowing a door (38) to be opened through a touch screen (30) and operation of a processor. However, there is no disclosure that the touch screen is only enabled to receive inputs in response to a matching card and PIN. There is certainly no disclosure or suggestion that the mechanic or pharmacist inputs through the touch screen, indicia corresponding to a particular medical item. Indeed there is no particular medical item that is accessed by opening door 38. As Blechl does not disclose these features and relationships which are expressly recited in claim 45, claim 45 is further allowable on this basis.

In the Action only features of Blechl are cited as allegedly pertinent to claim 45. No specific features of Weinberger are cited with regard to this claim. However the Action admits that Blechl does not anticipate claim 45 because no § 102 rejection is presented against claim 45 based on Blechl. As the Action cites no source of other features, or any teaching, suggestion or motivation in the relevant art to modify Blechl so as to produce the invention specifically recited in claim 45, the Action does not present a valid §103 rejection and claim 45 is allowable.

As the Action does not state a valid basis for rejection of claim 45 and further because claim 45 specifically recites features and relationships which are not found in the cited reference, claim 45 as well as the claims that depend therefrom (claims 46-47) are allowable.

## **Claims That Depend From Claim 45 Recite Further Patentable Features Claim 46**

### **Claim 46**

Claim 46 depends from claim 45 and further recites that the lock comprises a visual indicator which provides an indication responsive to at least one signal, that the door is enabled to be opened. The Action cites to Blechl (Column 7, lines 13-34) for disclosing such a feature. Applicants respectfully submit that this portion of Blechl does not disclose or suggest such a feature.

The cited portion of Blechl refers to a wire (124) shown in Figure 6 which extends through a pair of apertures in a cartridge. The wire is broken to release the medication containers stored in the cartridge. The unbroken condition of the wire indicates that none of the medication containers have been removed.

This breakable wire of Blechl in no way provides a visual indication in response to at least one signal as specifically recited in claim 46. Further this feature of Blechl does not provide an indication that a door is enabled to be opened as specifically recited in claim 46.

The Action apparently asserts that Weinberger includes a lock module which provides a visual signal that directs a user to a correct door/drawer. However no portion of Weinberger is cited for this teaching. Further, no teaching, suggestion or motivation for combining features of Weinberger with features of Blechl is presented in the Action.

It is respectfully submitted that claim 46 is further allowable for these reasons.

### **Claim 47**

Claim 47 depends from claim 45 and further recites that the lock comprises a door sensor. The door sensor is operative to generate an open signal responsive to opening the door. Claim 47

further recites that the computer operates responsive to the open signal to change the lock to the locked condition. As a result when the door is next returned to a closed condition, the door is held closed.

The Action cites Column 13, lines 20-30 of Blechl as disclosing this feature. However, Blechl ends at Column 13, line 27. In addition the cited portions of Blechl are claims 17-19 which teach, disclose or suggest nothing concerning the features specifically recited in claim 47.

The Action asserts that Weinberger includes a computer to lock a door responsive to a sensor indicating door closure. However, no particular element or portion of the Weinberger is cited in the Action as disclosing this particular feature. Further, no specific teaching, suggestion or motivation is cited in either Weinberger or Blechl for combining features so as to produce what is expressly recited in claim 47.

For these reasons it is respectfully submitted that claim 47 is further allowable.

**Applicants' Claims Should Be Allowed Because the Action Has Not Shown That the Features and Relationships Claimed Are Known in the Prior Art**

It is respectfully submitted that all the pending claims should be allowed because the Action has failed to recite with the legally required specificity, where the recited elements are shown in the prior art. In the case of all obviousness rejections, the Action has failed to specify a teaching, suggestion or motivation found in the prior art for purposes of making the claimed combination.

It is respectfully submitted that the citation in the Action to blocks of text without any reference to the particular feature or teaching which is alleged to correspond to the recited claim elements, does not provide in a legally sufficient way a valid basis for rejecting the claims.

Further as discussed in detail herein in relation to the rejections which are not overcome by swearing behind the cited references, the portions of the references cited in the Office Action generally do not stand for the propositions asserted in the Action and often have no bearing whatsoever to the features specifically recited.

In this regard Applicants respectfully wish to point out the deficiency in the Action in responding to their request in the prior response for a showing that the use of permanent magnet solenoids were known in the prior art of medical item dispensing systems, and for a specific citation to some teaching, suggestion or motivation to include such a device in the recited combinations. In the prior response Applicants challenged the assertion that "official notice" could be taken that use of permanent magnets in solenoids is well known because such construction "averts the need for plural windings". In response to the traverse of the "official notice" rejection, the Patent Office in the recent Action cited the abstracts in Keskin, Nemoto and Tabata. None of these patents have to do with the relevant art of medical item dispensing systems. No teaching, suggestion or motivation in the relevant art was cited to include features of these patents in connection with a medical item dispensing system. None of these patents show the asserted advantage of averting the need for plural windings, and in fact do not have such advantage. Finally the citation in the Action to the abstract of Keskin does not even discuss the use of a permanent magnet for any purpose.

Applicants respectfully submit that in view of the plainly legally insufficient basis for rejecting Applicants' claims, that all of the claims should be allowed.

**Conclusion**

Applicants have submitted herewith a Declaration which establishes that they reduced their invention to practice in this country so as to obviate all of the rejections presented in the Action against claims 1-3 and 24-26. It is respectfully submitted that these claims are allowable. It is further respectfully submitted that because the allowable claims include linking claims, upon which the claims which have been withdrawn from consideration are based, it is respectfully submitted that claims 4-23 and 27-44 are also now allowable.

Applicants have also established herein that claims 45-47 are patentably distinguishable over the cited references which have not been sworn behind. It is therefore respectfully submitted that all claims are allowable.

Respectfully submitted,

  
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